SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968
NO. 949

KAISER INDUSTRIES CORPORATION, VEREINIGTE OESTERREICHISCHE EISEN-UND STAHLWERKE AKTIENGESELLSCHAFT, and BRASSERT OXYGEN TECHNIK AG., Petitioners,

v.

McLOUTH STEEL CORPORATION, Respondent.

PETITIONERS' REPLY TO BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION

WILLIAM H. WEBB
1502 Oliver Building
Pittsburgh, Pennsylvania 15222
Counsel for Petitioners

JOHN A. DIENNER
53 West Jackson Blvd.
Chicago, Illinois 60604

JOHN M. WEBB
DAVID C. BRUENING
1502 Oliver Building
Pittsburgh, Pennsylvania 15222

W. BROWN MORTON, JR.
425 Thirteenth Street, N.W.
Washington, D.C. 20004

GEORGE E. BRAND, JR.
1881 First National Building
Detroit, Michigan 48226
Of Counsel

SMITH BROS. CO. INC., LAW PRINTERS, 620 SECOND AVENUE, PITTSBURGH, PA. 15219

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Respondent's brief neither denies nor traverses effectively the reasons advanced by petitioners as to why this Court should grant the Petition. In reality, it emphasizes the fact that the decisions below are in conflict with prior decisions of this Court and various Courts of Appeals.

I.

Respondent's assertion (Br. 3-4) that the process of the Suess et al. patent is not the basic oxygen steelmaking process is obviously incorrect in view of the findings of the District Court set forth at pages 9, 10 and 18 of the Petition. The District Court found that

the specification teaches this revolutionary basic oxygen process, that it was patentable and that it is used at Linz, by defendant and by others throughout the world (App. A, pp. 46a, 62a, 68a, 158a, 202a).

The only bases for respondent's statement and for the assertion in its restated question that concurring opinions below held that the *claims* "covered the prior art" are the misconstruction of the claims resulting from the refusal of respondent and the Courts below to look to the file wrapper history to construe the claims and the erroneous application of the doctrine of file wrapper estoppel. This misconstruction is the basic question presented. Thus, respondent's assertions beg the question.

II.

Respondent does not even attempt to support the erroneous interpretation and application of the file wrapper estoppel doctrine used by the courts below to defeat the patent in suit (Question 2).* Respondent neither denies nor rebuts petitioners' arguments demonstrating the total inapplicability of that doctrine, which was so heavily relied upon by the District Court (App. A, pp. 164a-167a, 175a).

III.

Respondent admits that, under this Court's decisions, an invention is to be construed "with reference to the file wrapper or prosecution history in the Patent Office" (*Graham* case) "to limit words to the meaning given them by the patentee in order to secure the allow-

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*Respondent's position here is consistent with its earlier actions. It neither pleaded file wrapper estoppel nor argued it in either of the courts below.

ance of the patent" (Br. 8). This is exactly what the courts below *expressly refused* to do, and is the error to which Question 1 is directed. The lower courts refused to "limit" the words used to the meaning *which the District Court expressly held was given to them in the file history* (App. 104a, 109a, 175a). Respondent does not challenge the District Court's holding that the file wrapper makes the words used clear and definite. It argues only that the file wrapper history cannot be used to clarify the meaning of those words. But, if, as the lower courts have held and respondent argues (Br., pp. 12-14), the claims when read *in vacuo*, i.e., without guidance of the file wrapper history, (1) include a "meaningless" term and (2) thereby overclaim the invention, but when read in light of the file history are (a) clear and definite and (b) limited to the "real gist of the invention," then the file history must be used to limit the words to the meaning given them by the patentees. The *Graham* case requires such a construction.

Thus, if we take respondent's admission and this holding of the District Court, it follows that the decisions below are in direct conflict with the *Graham* case and other decisions of this Court.

The only reason given by respondent and the lower courts for their *refusal* to refer to the file history is that someone interpreting a patent claim should not be required to go further than the specification and the knowledge of those skilled in the art to determine the meaning of the claim. The courts below gave no reason why a person interpreting a patent should not be required to review the file history. It is, in fact, the general practice of all those interpreting a claim of a patent to refer to the file history.

Respondent (and also the District Court) further suggests that, since the affidavits were not filed until seven years after the original application was filed, they should not be considered. However, the affidavits and the amendment, which petitioners assert should be considered, were filed *at the same time* that the claim language sought to be clarified was first used. Obviously, the meaning of specific words need not be and cannot be explained until they are used. Also, claims are not considered or interpreted by third parties until the patent issues, at which time the file history becomes available to all.

IV.

Respondent's detailed arguments on lack of support for the claims in the specification, overclaiming and covering the prior art beg or evade the real question presented (Question 1), *i.e.*, the proper legal standards to apply in construing the claims. If the proper standards are applied and the claims properly construed in the light of the file wrapper history (particularly the Hauttmann affidavit) and the specification, the alleged overclaiming, covering of the prior art and lack of support completely disappear.*

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*Respondent, in its briefs in response to the Petition and the Amicus brief, has made many incorrect, incomplete and misleading statements as to both the evidence and the holdings below. However, we will not reply to them herein because they are irrelevant and immaterial as to the issues presented by the Petition.

V.

The decisions below should not be allowed to stand. The legal issues and policy considerations presented are of great importance and should be settled by this Court; and the grossly inequitable result reached by the courts below should be erased.

Respectfully submitted,

WILLIAM H. WEBB
1502 Oliver Building
Pittsburgh, Pennsylvania 15222
Counsel for Petitioners

JOHN A. DIENNER
53 West Jackson Blvd.
Chicago, Illinois 60604

JOHN M. WEBB
DAVID C. BRUENING
1502 Oliver Building
Pittsburgh, Pennsylvania 15222

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